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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/243,016	02/02/99	LENZ	D BEIERSDORF54

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EXAMINER

GHALI, I

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 05/01/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

## Office Action Summary

Application No.  
09/243,016

Applicant(s)  
Lenz et al.

Examiner  
Isis Ghall

Art Unit  
1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Mar 29, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The receipt is acknowledged of applicants' change of address, request for extension of time for one month, and notice of appeal, all filed 12/15/2000. The receipt is acknowledged of applicants' petition for extension of time for another two months, request for filing under 1.53(d), and IDS, all filed 3/29/2001.

Claims 1-13 are pending in the application.

#### ***Continued Prosecution Application***

1. The request filed on 3/29/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/243,016 is acceptable and a CPA has been established. An action on the CPA follows.

#### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, as the claims are directed to light occlusive patch and not occlusive plaster.

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3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the claim is confusing as reciting "an internal contour is printed in black on the upper side". Is the black print on the internal contour or on the upper side ? And which layer that the applicants are printing ?

Claim 6 recites the limitation "polyesterurethane" in claim 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "a two dimensional textile structure" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 10, the claim is reciting "unfoamed polyurethane is applied to the top or two dimensional textile structure, selected from..... is embedded in the top layer". It is unclear

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if the unfoamed polyurethane is applied or embedded on the top layer. It is also unclear if it is the polyurethane or the textile structure that is selected from nonwoven, knit or wovens ?

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 89/04649 ('649).

WO '649 disclosed an occlusive opaque eye patch comprising an outer polymeric layer, intermediate foam layer, inner pressure sensitive adhesive layer and inner member of black felt which is dimensioned so that it can be placed concentrically within the edges of the adhesive layer so that peripheral portion of the adhesive is exposed to be attached to the skin. The adhesive portion is secured with a cover that can be peeled off at use. See page 1, lines 3-6; page 5, lines 1-12, 23-30; page 6, lines 1-3.

8. Claims 1, 5, 6, 10, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,908,645 ('645).

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US '645 disclosed an eye bandage comprising a layer of polyurethane foam, covered with non-woven web material of polyester on one side and pressure sensitive adhesive layer on the other side. The pressure sensitive adhesive is covered with a release liner. The reference disclosed foaming the polyurethane between two liners. See abstract; col.1, lines 44-58; col.2, lines 30-43; col.3, lines 31-44; col.4, lines 3-4, 35-50; col.6, lines 9-16.

9. Claims 1, 5, 6, 8, 10, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,538,603 ('603).

US '603 disclosed an occlusive dressing comprising polyurethane foam layer covered by polymeric film of polyurethane on one side and pressure sensitive adhesive on the other side. The adhesive is covered by release liner. The foam layer have a thickness from 0.03 to 0.1 inch (0.75 to 2.4 mm). The reference disclosed a method of making the patch included laminating the adhesive to the foam layer after its drying. See abstract; col.2, lines 14-28; col.4, lines 25-51; col.5, lines 1-48; col.6, lines 34-54.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '649, US '645, US '603, or US 5,844,013 ('013) each by itself or in combination.

US '013 are teaching a wound dressings such as wound plasters and adhesive plasters comprising a polyurethane film as a backing and a polyurethane gel foam together with a filler such as chalk or kaolin and also it is possible to use dyes or colored pigments to confer the required colors. The reference also disclosing a process of producing polyurethane foams including combining and mixing together the polyurethane, the foaming agent and filler and then foaming by stirring or beating in air and then spread the mix out to a sheet like structure. The thickness of the polyurethane foam layer can be 0.1 to 1.0 mm. and has a density of 0.25 0.75 g/square cm. The foam according to this reference can be applied to sheet like backing which is preferably provided with a polyurethane gel foam layer. See col.4, lines 18-19, lines 39-40, lines 60-61; col.6, lines 46-59; col.16, lines 25-50; col.17, lines 11-13, lines 61-65; col.18, lines 38-45.

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WO '649 does not disclosed polyurethane as a foam material or method of making the patch, US '645, US '603 and US '013 disclose polyurethane foam and process of its making.

It is within the skill in the art to adjust thickness and density of dressing according to their specific use. Black or opaque eye patches are well known in the ophthalmic medicine.

Accordingly, it would have been obvious for one having ordinary skill in the art at the time of the invention to produce an occlusive patch consisting of at least one layer of foam material with adhesive on its lower layer with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,191,897 disclosed self adhesive eye occluder which is opaque. US 5,429,592, US 5,681,579, EP 0 732 108 and EP 0 691 113, all disclosed dressings comprising foam layer of polyurethane and pressure sensitive adhesive.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 7:00 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Isis Ghali

Patent Examiner

April 27, 2001.

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

